

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
)
Wm. A. KNAUS et al.) Group Art Unit: 3626
)
Application No: 09/822,261) Examiner: Lena Najarian
)
Filed: April 2, 2001)
)
Title: **BROADBAND COMPUTER-BASED NETWORKED SYSTEMS FOR**
CONTROL AND MANAGEMENT OF MEDICAL RECORDS

MAIL STOP = APPEAL BRIEF - PATENTS

Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO EXAMINER'S ANSWER

Honorable Sir:

The Examiner's June 4, 2007 Answer (the "Answer") fails both to analyze and rebut the legal arguments and factual recitations in Appellant's October 30, 2006 Brief on Appeal (the "Brief"), as we show below. The Examiner's inability to support the reasoning behind the rejections is eloquent demonstration that the rejections are improper, that Appellant's application satisfies established legal standards, and that Appellant is entitled to an immediate withdrawal of the rejections.

The Answer seeks to justify the rejections in six categories, labeled A through E. Answer at 22-27. Appellant will address these categories in order of relevance, rather than chronologically, to pinpoint the obvious, fatal deficiencies in the rejections themselves, which remain uncorrected and unsupported in the Answer.

**The Examiner's Inconsistent Interpretations of
"Certification," "Non-Repudiation," and "Accuracy"
Demonstrate That the Rejections Must Be Withdrawn**

Arguments “A,” “B” and “E” of the Answer consider Appellant’s discussions of the terms “certification,” “non-repudiation,” and “accuracy.” In Argument “A,” the Examiner states that “[t]he difference between ‘patient-based’ and ‘hospital-based’ is simply in who created the initial records” in refuting Appellant’s position that Shepard teaches against Appellant’s claimed invention. Answer at 24. However, the differences between these two systems include more than the identity of the record drafter, as is evident from the claimed invention’s capability of non-repudiation and vetting or certification. To reiterate Appellant’s Brief at 11, the information contained within Shepard’s source medical records *cannot* be better than exists at the source from which the record was obtained. This is at least because the hospital, physician or health care worker is the source of the record. In other words, the Shepard system only envisions creating original medical records at the source. Therefore, Shepard cannot logically be a system of creating medical record[s] that are ‘better’ than exist at the source from which the records were originally obtained (*i.e.* better than the original record). Accordingly, Shepard indeed teaches against Appellant’s claimed invention, and all rejections based on Shepard should be withdrawn for failure to disclose or suggest Appellant’s claimed invention and for failure to establish a *prima facie* case of obviousness.

The Examiner’s further extensive discussion on lexicography of claim language in Arguments “A” and “B” is irrelevant to her rejections. Appellant is not insisting on being its own lexicographer but rather insisting on consistency. The Examiner has stated that she cannot find support for “the meanings currently argued by Appellant” for the terms “certification” and “non-repudiation.” Answer at 23 and 25. However, Appellant is only attempting to respond to the inconsistent meanings posited by the Examiner for these terms. In highlighting certain specification passages that address the elements of “certification” and “non-repudiation,” Appellant is not incorporating a definition from the specification into the claims but merely demonstrating that the specification is consistent with the context and plain meaning of these terms in the claims. Appellant Brief at 2. The Answer fails to refute Appellant’s point that the

Examiner cannot have it both ways and sustain rejection. No matter whether the words of the claims are given a special meaning or their normal English meaning, Appellant shows that a consistent interpretation of the terms in question inevitably leads, either way, to a withdrawal of the rejections based on Snowden and Malik. Appellant's Brief at 12.

The Examiner states that she "gave each term the broadest reasonable interpretation in light of the Applicant's specification." Answer at 23 and 25. This statement is simply incorrect. What the Examiner did was to give each term two mutually-exclusive interpretations depending on what suited her arguments. The Examiner's attempt to justify her interpretations of these words only underscores the facial inconsistency, and thus the legal insufficiency, of her approach.

In a first instance, the Examiner defined "certification" and "non-repudiation" as equivalent in meaning to "accuracy" in order to reject certain of Appellant's claims over Snowden and Malik. See pages 6-7 in the non-final Office Action mail dated August 1, 2005. Appellant rebutted the rejection by swearing behind Snowden and Malik with a § 1.131 Affidavit which demonstrated that Appellant's invention included "accuracy" before the date of the asserted prior art. At this juncture, the Examiner changed her interpretation and declared that the term "accuracy" in the Affidavit did not mean "certification" or "non-repudiation," thus contradicting the basis of her initial rejection.

These consequences are straightforward. If "certification" and "non-repudiation" are given their normal English meanings, Snowden and Malik are not relevant prior art, and all rejections based in any part on Snowden and Malik are in error.

If, however, "accuracy" is interpreted to mean "certification" and "non-repudiation," then the Affidavit is sufficient to swear behind Snowden and Malik, because the Affidavit then covers "accuracy."

The Answer arbitrarily and capriciously shifts the meaning of words in the claims in order to support mutually inconsistent rejections, despite how the applicant uses those words in the claims and the specification. This defect in processing is both obvious and unsustainable.

**The Examiner Fails to Justify Imposing a “Completed”
Invention Requirement for 37 CFR § 1.131 Affidavits Under MPEP 715.02**

Arguments C and D consider Appellant’s affidavit (“Affidavit”) swearing behind Snowden and Malik. Answer at 26. The Examiner states that “Appellant fails to sufficiently show that his invention as claimed was completed prior to the date of the applied references.” Answer at 26 (emphasis in original). However, this is an erroneous assertion because Appellant need not demonstrate that it was in possession of the completed claimed invention. MPEP §715.02 requires Appellant only to show that its Affidavit contain the elements of the claimed invention that are found in the supposed prior art:

[A]n affidavit is not insufficient merely because it does not show the identical disclosure of the reference(s) or the identical subject matter involved in the activity relied upon. If the affidavit contains facts showing a completion of the invention commensurate with the extent of the invention as claimed is shown in the reference or activity, the affidavit or declaration is sufficient.

The Appellant is therefore not required to disclose its entire claimed invention in the Affidavit. It is more than sufficient that the Affidavit establish possession of something falling within the claim to the extent that it is allegedly disclosed in a cited reference. Appellant’s Affidavit establishes possession of the elements of the claimed invention as interpreted by the Examiner. Consequently, if the meaning of “accuracy” is deemed to include “non-repudiation” and “certification,” then the Affidavit is sufficient to swear behind Snowden and Malik. If “accuracy” is not deemed to include “non-repudiation” and “certification,” then Snowden and Malik are not relevant prior art. In either event, the rejections based on Snowden and Malik must be withdrawn.

Appellant has no need to repeat the extensive legal analysis of these issues in its Brief (at 12-16). It is sufficient that the Examiner has no response whatsoever to these documented, specific, conclusive legal arguments. The Examiner’s analytical approach to Appellant’s Affidavit is contrary to the MPEP, and thus clear error. Snowden and Malik should be removed as prior art references in view of Appellant’s Affidavit.

Conclusion

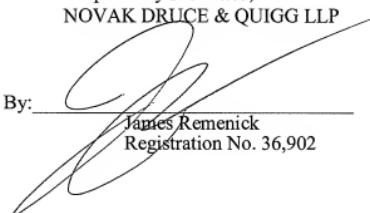
All other arguments in Appellant's Brief stand untouched in the Answer.

Appellant respectfully requests that the rejections be withdrawn and that the claimed invention be declared allowable.

If any fees are deemed required in the filing of this reply, please charge any shortage in fees due in connection with the filing of this paper to Deposit Account 14-1437, referencing Attorney Docket No. 8123.003.

Respectfully submitted,
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